

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

CHESNUT *et al.*

Appl. No. 10/005,876

Filed: December 7, 2001

For: **Methods and Compositions for
Synthesis of Nucleic Acid
Molecules Using Multiple
Recombination Sites**

Confirmation No.: 7958

Art Unit: 1636

Examiner: Ketter, J.S.

Atty. Docket: 0942.5340002/RWE/BJD

Reply to Restriction Requirement

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated July 24, 2003, requiring an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 1-15, 44 and 45, drawn to nucleic acids, vectors containing same, and cells containing said vectors. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed. Applicants reserve the right to file one or more continuation and/or divisional applications directed to the non-elected inventions.

This election is made **with** traverse. Reconsideration and withdrawal of the restriction requirement, and consideration of all pending claims, are respectfully requested. The criteria for a proper requirement for restriction are that (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. MPEP § 803.

Applicants respectfully assert that the claims in Groups I and II are closely related in subject matter. As such, a search of one group of claims is likely to encompass subject matter pertinent to the patentability of both groups. Hence, Applicants respectfully assert that a serious burden would not be imposed on the Examiner if restriction were not required. According to the guidance of the MPEP, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803. Hence, reconsideration and withdrawal of the Restriction Requirement, and consideration of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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